

REMARKS

Claims 1-5, 9, 11-15, 18-22, and 27-46 are pending in the present application. In the above amendments, claims 1, 18, and 29 have been amended. Claims 47 and 48 have been newly added. Therefore, after entry of the above amendments, claims 1-5, 9, 11-15, 18-22, and 27-48 will be pending in this application. Applicants believe that in light of the amendments and remarks presented herein the present application is now in condition for allowance. Applicants respectfully request prompt and favorable action.

Summary of the Office Action

In the Office Action: claims 1-5, 9, 11-15, 18-22, and 27-35 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; claims 1-5, 11, 13, 14, 18-22, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare *et al.* (U.S. Patent No. 5,978,671) in view of Kitchings (US 2003/0190020) further in view of Landell *et al.* (U.S. Patent No. 4,994,983); claims 9 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare *et al.* in view of Kitchings further in view of Landell *et al.* further in view of Brady (U.S. Patent No. 5,982,857); claims 12 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Foladare *et al.* in view of Kitchings further in view of Landell *et al.* further in view of Bambini (U.S. Patent No. 5,898,392); claims 29-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson (U.S. Patent No. 5,802,149) in view of Kitchings further in view of Motohashi (U.S. Patent No. 6,351,639); and Claims 42-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Motohashi. These rejections are traversed based upon the foregoing amendments and the following remarks.

Response to Rejection of Claims 1-5, 9, 11-15, 18-22, and 27-35 Under 35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 1-5, 9, 11-15, 18-22, and 27-35 under 35 U.S.C. § 112, second paragraph. Specifically, claims 1, 18, and 29 stand rejected as indefinite for failing to specify which of two wireless communication devices was referred to by the phrase “wireless communication device.” Applicants have amended claims 1, 18, and 29 to refer to “the wireless communication device” consistent with the antecedent for this phrase existing in the preamble. Thus the phrase “wireless communication device” is not indefinite in the amended claims. Accordingly, Applicants respectfully request that the rejections of claims 1, 18, 29 and their respective dependent claims 2-5, 11-15, 19-22, 27-28, and 30-35 under 35 U.S.C. § 112, second paragraph be withdrawn.

Response to Rejections of Claims 1-5, 9, 11-15, 18-22, 27 and 28 Under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” M.P.E.P. § 2142. Applicants respectfully submit that claims 1-5, 9, 11-15, 18-22, 27 and 28 are patentably distinct from the cited references, because the cited references do not teach or suggest all of the limitations in the claims.

Claim 1 recites “prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved.” As described in paragraph [0032], the “voice tag” is a recording made by the user of the wireless communication device so that “[a]fter the voice tag is saved, the caller can utilize the voice dialing feature by speaking the voice tag into the cellular telephone's microphone, and the cellular telephone connects the caller to the telephone number matched to the voice tag.” In this way, the voice tag can be subsequently used to speed dial an intended recipient via voice command.

In contrast to the invention recited in claim 1, Foldare states:

the system prompts a *caller* to speak a word or phrase such as *his name* and speech recognition techniques are used to obtain characteristic features of the caller's speech which can be used as caller identity information for querying the caller database. In this manner, the system is able to identify a caller independent of the calling telephone ANI that was used to place the call. The ANI of the calling telephone can still be used as supplemental information in identifying a repeat caller. Further, the use of caller identity information based on the caller's speech characteristics enables the system to provide the option of a suggested alphanumeric identifier that was generated using speech-to-text techniques on a caller's spoken name.

Foldare, column 2, line 58 through column 3, line 3 (emphasis added). Foldare discloses that audible identifiers are used to identify incoming calls, rather than outgoing calls. Foldare states:

It is possible to employ an audible identifier for the caller identity information to better identify the caller to the bridging and signaling unit 50. Suitable audible identifiers include, for example, characteristic features of the caller's voice or tones generated with the calling telephone's keypad, individually or in combination. As a result of such audible identifiers, *a caller can be identified as a repeat caller even if he uses different telephones to call the subscriber.*

Foldare, column 6, lines 52-59 (emphasis added). Thus, Foldare prompts the party making the incoming call to speak a word or phrase, not the user. Consequently, Foldare fails to disclose or suggest "prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved."

None Kitchings, Landell, Brady, or Bambini taken alone or in combination cure this deficiency of Foldare. In view of the foregoing, Applicants submit that claim 1 is patentably distinct from the combinations of Foldare, Kitchings, Landell, Brady, and Bambini. Because claims 2-5, 9, and 11-15 depend from claim 1, Applicant submits that claims 2-5, 9, and 11-15

are allowable for at least these reasons. Accordingly, Applicants respectfully request that the rejections of claims 1-5, 9, and 11-15 be withdrawn.

Claim 18 recites “to prompt the user to save a second voice tag corresponding to said first telephone number when a first voice tag corresponding to any telephone number has already been saved.” As discussed above, Foldare does not teach or suggest prompting the user to save a voice tag. Rather, Foldare prompts a party making the incoming call to speak a word or phrase, not the user. None of Kitchings, Landell, Brady, or Bambini taken alone or in combination cure this deficiency of Foldare. In view of the foregoing, Applicants submit that claim 18 is patentably distinct from combinations Foldare, Kitchings, Landell, Brady, and Bambini. Since claims 19-22, and 27-28 depend from claim 18, Applicants submit that they are patentable for at least this reason. Accordingly, Applicants respectfully request that the rejections of claims 18-22 and 27-28 be withdrawn.

Response to Rejections of Claims 29-46 Under 35 U.S.C. § 103

Applicants respectfully submit that claims 29-46 are patentably distinct from the cited references because the cited references do not teach or suggest all of the limitations in these claims.

Claim 29 recites “checking whether said voice tag is a first voice tag to be saved at the wireless communication device.” Hanson, alone or in combination with Kitchings and Motohashi, does not suggest this claim element.

Instead, Hanson states:

If it is determined at step 210 that the tag that was received from the caller at step 204 does not match any of the tags that are stored in the caller's voice-dialing directory 130, system 107 announces to the caller that the tag was not recognized and prompts the caller to indicate whether he or she wants directory assistance, at step 218.

Hanson, Col. 4, lines 5-10.

This test does not equate to checking whether a voice tag is a first voice tag to be saved at the wireless communication device. The relevant test in Hanson is whether the caller input matches any voice tags that had been previously stored in the phone. The test will fail (i.e. prompt the user for directory assistance) not just when there are no voice tags in the database, but also when the user misspeaks (i.e. the user says “MIKE” where the intended contact is stored as “MICHAEL” or “SMITH”) or the voice input is garbled by background noise or an unexpected sneeze. A test that is equivalent to the claimed element can return only one result if a voice tag corresponding to any number is stored in the database, and the opposite result if there is not.

Neither Kitchings nor Motohashi taken alone or in combination with Hanson cure this deficiency of Hanson. In view of the foregoing, Applicants submit that claim 29 is patentably distinct from the combinations of Hanson, Kitchings and Motohashi. Since claims 30-35 depend from claim 29, Applicants submit that claims 30-35 are also patentable for at least this reason. Accordingly, Applicants respectfully request that the rejection of claims 29-35 be withdrawn.

Claim 36 recites “checking whether a first voice tag corresponding to any telephone number has already been saved at the wireless communication device.” Hanson, alone or in combination with Kitchings and Motohashi, does not suggest this claim element. For at least the same reasons as discussed with respect to claim 29, Applicants submit that claim 36 is patentably distinct from combinations of Hanson, Kitchings and Motohashi. Since claims 37 and 38 depend from claim 36, Applicants submit that claims 37 and 38 are also patentable for at least this reason. Accordingly, Applicants respectfully request that the rejection of claims 36-38 be withdrawn.

Claim 39 recites “checking whether a new voice tag is a first voice tag to be successfully saved at the wireless communication device.” Hanson, alone or in combination with Kitchings

and Motohashi, does not suggest this claim element. For at least the same reasons as discussed with regard to claim 29, Applicants submit that claim 39 is patentably distinct from combinations of Hanson, Kitchings and Motohashi. Since claims 40 and 41 depend from claim 36, Applicants submit that claims 40 and 41 are also patentable for at least this reason. Accordingly, Applicants respectfully request that the rejection of claims 39-41 be withdrawn.

Claim 42 recites “providing a user with a first prompt for guidance when said feature of said wireless communication device has not previously been utilized.” Hanson, alone or in combination with Motohashi, does not suggest this claim element. For at least the same reasons as discussed with regards to claim 29, Applicants submit that claim 42 is patentably distinct from Hanson and Motohashi. Since claims 43 and 44 depend from claim 42, Applicants submit that claims 43 and 44 are also patentable for at least this reason. Accordingly, Applicants respectfully request that the rejection of claims 42-44 be withdrawn.

Claim 45 recites “checking whether a first feature of said wireless communication device has previously been utilized.” Hanson, alone or in combination with Motohashi, does not suggest this claim element. This element is similar to the element of claim 42 previously discussed. As discussed above, the Hanson test does not succeed or fail based on whether the voice dialing feature has or has not been previously utilized. Rather, it merely compares a user input for a match with the stored voice tags. In view of the foregoing, Applicants submit that claim 45 is patentably distinct from the combination of Hanson and Motohashi. Since claim 46 depends from claim 45, Applicants submit that claim 46 is allowable for at least this reason. Accordingly, Applicants respectfully request that the rejection of claims 45 and 46 be withdrawn.

Newly Added Claims

Applicants have newly added claims 47 and 48 to the present application. Claim 47 is directed toward a computer readable medium and incorporates all the limitations for claim 29.

Claim 47 is directed toward an apparatus and incorporates all the limitations of claim 29.

Therefore, claims 47 and 48 are patentable for at least the same reasons as claim 29. Applicants respectfully submit that claims 47 and 48 are in condition for allowance and respectfully request allowance.

CONCLUSION

In light of the amendments and remarks contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated January 8, 2008

By: /Nicholas A. Cole/

Nicholas A. Cole
Reg. No. 60,957
(858) 658-1834

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 658-5787
Facsimile: (858) 658-2502